

Dew et al would likely result in necrosis of the vein and therefore no reconstruction.

Remark 9:

With all due respect, Applicant requests the Examiner withdraw Roth as an anticipating reference under 35 USC 103(a). Roth fails to teach an endovenous method of treating a varicose vein using a pull-back device. Roth is directed to the treatment of enlarged prostate using an Nd:YAG laser. As described above, the longer wavelength energy used in the present invention is selectively absorbed at a greater rate than those of the Roth reference, and the endovenous process of destruction of varicose veins in the lower trunk and legs is totally different than the method and apparatus for treatment of benign prostatic hyperplasia (BPH) to which Roth is directed.

Remark 10:

With all due respect, Applicant requests the Examiner withdraw Conn and Makower as anticipating references under 35 USC 103(a). Conn and Makower are both also directed to treatment of the prostate as well as treatment of tumors and diseased tissue. These applications are fundamentally different, utilize different equipment and operate in completely different organs of the body located in different portions of the body.

Remark 11:

Finally, it is well settled that in order for references to be properly combined, there must be a teaching in at least one of the references to suggest that the disclosure of any of the other references could be modified to produce the Applicants' claimed invention. ACS Hospital System, Inc. v. Montefiore Hospital et al., 221 U.S.P.Q. 929 (Fed. Cir. 1984); Orthopedic Equip. Co. v. U.S., 217 U.S.P.Q. 193 (Fed. Cir. 1983). Additionally, absent some suggestion or incentive, the teachings of references may not be combined. ACS, supra, 221 U.S.P.Q. 933, In re Rinehart, 531 F. 2d 1048, 189 U.S.P.Q. 143 (C.C.P.A.

1976).

In the present case, there would be no incentive to combine the teachings of Goldman et al with that of Dew et al. Utilizing the methodology and apparatus of Dew et al to perform the procedures described in Goldman et al would have either the same effect on the varicose veins as Goldman et al or would be useless, i.e., there would be no obvious outcome which would be superior to the result taught by Goldman et al itself. Thus in the present case, since the outcome would not any different, there would be no incentive to combine the teachings of Goldman et al with that of Dew et al.

Remark 12: (NO NEW MATTER)

Applicant submits that the amendments presented herein present no new matter. All of the subject matter claimed herein are taught in the Drawings, Specification, Claims and Abstract and other portions of the Application as originally filed.

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CONCLUSION

Applicant respectfully submits that for all the foregoing reasons, the claimed subject matter describes patentable invention. Furthermore, Applicant submits that the specification is adequate and that the claims are now in a condition for allowance. No new matter has been entered.

Applicant hereby respectfully requests Examiner to withdraw the cited references as anticipating or obviating prior art, enter these amendments, find them descriptive of useful, novel and non-obvious subject matter, and authorize the issuance of a utility patent for the truly meritorious, deserving invention disclosed and claimed herein.

Without further, Applicant does not intend to waive any claims, arguments or defenses that they may have in response to any official or informal communication, paper, office action, or otherwise, and they expressly reserve the right to assert any traverse, additional grounds establishing specificity and clarity, enablement, novelty, uniqueness, non-obviousness, or other patentability, etc.

Further, nothing herein shall be construed as establishing the basis for any prosecution history or file wrapper estoppel, or similar in order to limit or bar any claim of infringement of the invention, either directly or under the Doctrine of Equivalents.

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Respectfully submitted,

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I hereby certify that this paper and the documents attached hereto are being deposited in a postage prepaid, sealed envelope with the United States Postal Service using First Class Mail service under 37 CFR 1.08 on the date indicated and is addressed to "Commissioner for Patents, Alexandria VA 22313-1450". Signed: _____

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